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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,480	11/20/2001	Indulis Gruzins	102123-200	3615

7590 10/03/2006

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,480

Applicant(s)

GRUZINS ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Final Rejection

The Status of Claims

Claims 1-25 and 27-31 are pending.

Claims 1-25 and 27-31 have been rejected.

Claim Objections

The objection of Claim 13 has been withdrawn due to the modification made in the amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 1-3, 5-19, 21-25, 27-29, and 31 under 35 U.S.C. 112, first paragraph has been withdrawn due to the modification made in the claims in the amendment .

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claim 13 has been withdrawn due to the modification made in the claims in the amendment. However, there is still another issue with claim 14 to be resolved.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the phrases "said low molecular weight polyol compound contains" is recited. The expression is vague and indefinite because the term "contains" would mean that there are other additional components besides the said low molecular weight polyol compound and at the same time the claim does not describe what has been excluded in the claim. The examiner may wonder what else is in the low molecular weight polyol compound. The examiner recommends to change from "contains" to "has". Therefore, an appropriate correction is required.

1. Applicants' argument filed 7/24/06 have been fully considered but they are not persuasive.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 1-25 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Housel et al (U.S. 6,103,822) in view of Koistinen et al (WO 98/50338).

The rejection of Claims 1-25 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Housel et al (U.S. 6,103,822) in view of Koistinen et al (WO 98/50338) has been maintained with reasons of record on 1/23/06.

Applicants' Argument

1. Housel does not suggest or disclose any catalyst other than an organometallic catalyst, such as organotin;
2. There is no motivation to combine the Housel with Koistinen et al, since Koistinen et al has disclosed only the tin oxide catalyst employed in examples of 1-3 and 5-31 and Housel discloses tin oxide catalyst to be used in the disclosure.

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3. There is no specific disclosure of any amount of acid catalyst in the Koistinen et al , much less any amount within the instantly claimed range.

First, with respect to the first argument, the Examiner has noted applicants' argument. However, the claims are not directed to the potential problems of forming unwanted side reactions as a result of using particular catalysts at a high temperature or to those problems with the long conversion to the acid polyol as a result of using particular catalysts at a low temperature , but the claims are directed to a low viscosity carboxyl containing polyol composition. Therefore, applicants' argument are irrelevant to the issue of the claims.

Second, with respect to the second and third arguments, the Examiner has noted applicants' argument. However, the Housel prior art does teach not only organotin as a catalyst , but also the use of "catalysts" in general (see col. 8 ,line 1) in the process ; in addition, Housel et al does describe the polymeric acid functional polyol which is the reaction product of polyols and the acid anhydride in the presence of tin metal oxide catalysts (see col. 13 ,lines 19-21) in an amount of from 0 to 30,000 ppm (see col. 13 ,lines 22-24) for the purpose of controlling the reaction.

Furthermore, Koistinen et al expressly teaches the use of " a catalyst" in general (see an abstract page) and a catalyst , such as sulfuric acid, hydrochloric acid or metal oxides, such as titanates or tin oxides (see page 3 , lines 17-18) in the

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amount of from 0.05 to 0.5 % of the reacting components (see page 3 ,lines 16-18) .

Regardless of which one of the catalysts has to be used in the process, the Koistinen et al does point out the term " a catalyst" which would imply that any catalyst would work for the process. Moreover, the Koistinen et al does offer guidance that there is an equivalence of teaching regarding the use of the catalyst between the hydrochloric acid and tin oxides. Therefore, there is a motivation to combine the prior art.

Furthermore, both prior art processes have commonly dealt with the production of carboxy-containing polyol composition with similar reaction conditions (i.e. reactants).

Therefore, it would have been obvious to the skillful artisan in the art to be motivated to employ Koistinen's et al hydrochloric acid into the Housel et al process as an alternative to the Housel's et al tin oxide because the skilled artisan in the art would expect such a modification to be successful and effective as guidance shown in Koistinen et al .

Therefore, applicants' argument are irrelevant to the issue of the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD,LAC
Primary Examiner
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9/28/06